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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Arthur Coello and Carlos Vega Velazquez

Serial No.: 10/672,425

Filing Date: September 26, 2003

For: TEMPORARY AQUEOUS AEROSOL PAINT COMPOSITION AND A
METHOD FOR PREPARING THE COMPOSITION

Confirmation No. 8437

Customer No. 04219

Group Art Unit 1713

Egwim, Kelechi C., Examiner

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

DECLARATION OF ARTHUR COELLO

I, ARTHUR COELLO, declare as follows:

1. That I am the co-applicant and co-inventor of the new and inventive composition disclosed and claimed in above-referenced U.S. Patent Application entitled TEMPORARY AQUEOUS AEROSOL PAINT COMPOSITION AND A METHOD FOR PREPARING THE COMPOSITION, and having Serial Number 10/672,425 (hereinafter "the Application").

2. That the inventive composition and method of preparation disclosed and claimed in the Application is based upon research conducted and/or directed by myself and/or my co-applicant and co-inventor, Carlos Vega Velazquez.

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3. That I received an Associate of Science in Building Construction Technology Degree from Miami-Dade Community College, located in Miami, Florida, in 1991, that I hold a Building Construction license and a General Contractor licenses in the State of Florida, that I have over fifteen (15) years of experience in the construction industry, and that I am currently Owner and Vice-President of Construction for Home Inspection Analysts, Inc. d/b/a H.I.A. Builders Inc.

4. That my co-applicant and co-inventor, Mr. Velazquez, received his Bachelor Degree in Chemical Engineering from the Universidad Autonoma Metropolitana, located in Pueblo, Mexico, in 1996, and has nearly ten (10) years experience in the field of chemical engineering, with specific experience in research and development of coating formulations.

5. That, in my opinion, the information presented herein includes no new matter and is presented solely in response to the Office Action of the U.S. Patent and Trademark Office of September 23, 2005, which states that "it would have been obvious to one having ordinary skill in the art, at the time the invention was made, to include these conventional additives to the aerosol paint compositions," as a basis to reject several of the claims originally presented in the Application.

6. That my co-inventor and I possessed at least ordinary skill in the art at the time the invention was made, and that

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extensive testing was required and performed to arrive at the inventive composition disclosed and claimed in the Application, and that the composition is not obvious.

7. That based on my experience in the construction industry I learned first hand the problems and pitfalls associated with purportedly temporary marking paint products utilized to mark boundaries, underground utilities locations, and other surfaces in and around a construction site, and that these temporary marks often remained visible for months and even years after they are applied to a surface, even where exposed to the environment.

8. That based on my experience in the construction industry I also learned that the available temporary marking paint products all contained some type of volatile organic compound that was harmful to persons applying the paint, as well as to other persons in the vicinity of the construction site who may be exposed to the paint, and that as a result of these volatile organic compounds the available temporary marking paint products were also harmful to the environment.

9. That in 1999, my co-applicant and I met with three engineers at the Instituto Mexicano Del Petrolio to discuss possible development of an aerosol paint composition that was really "temporary" and that did not require the volatile organic compounds that are harmful to user's and the environment, and

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that we were told by each of the three engineers that it was impossible to make such a composition.

10. That between approximately February 2000 and June 2001, numerous experimental formulations were prepared including one of a variety of polymeric resins common in paint compositions including a long chain polysaccharide resin, a modified methyl methacrylate resin, a styrene-acrylic resin, and a vinyl acrylic resin, and that each of these experimental formulations failed to produce the desired composition as they all required at least some amount of a volatile organic compound as a solvent to maintain stability and to prevent precipitation of the final paint composition.

11. That the experimental formulations including a polysaccharide resin and the experimental formulations including a methyl methacrylate resin exhibited strong adhesion to the surfaces it was applied and that was contrary to the desired "temporary" paint composition as disclosed in the Application.

12. That in approximately June 2001, an experimental formulation including an aqueous dispersion of polyvinyl acetate dispersion, as disclosed and claimed in the Application, proved to resolve the issue of a stable formulation that did not require the addition of a volatile organic solvent.

13. That between approximately June 2001 and January 2003, experimental formulations were prepared and tested to determine

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the type and amount of bactericide to include in the "temporary" paint composition, and that a custom valve was developed specifically to permit application of our composition from an inverted aerosol can

14. That between January and August 2003, final experimental formulations were prepared and tested including various concentrations of UV inhibitor, from zero to 3%, until the concentration which resulted in a composition exhibiting the desired "temporary" properties was developed, and that an aqueous aerosol paint composition prepared in accordance with the formulation disclosed and claimed in the Application will degrade on its own upon exposure to the elements within about four (4) weeks of application to a surface.

15. That in September 2003, the Application was prepared and filed to secure patent protection on the new and inventive aqueous aerosol paint composition developed by myself and my co-inventor and co-applicant, Carlos Vega Velazquez.

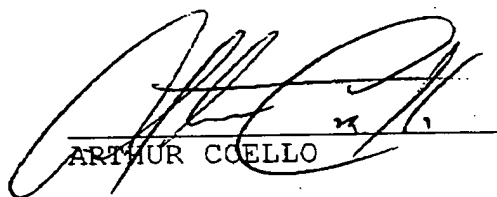
16. That our development of an aerosol paint composition that is really "temporary" and that does not include volatile organic compounds that are harmful to user's and the environment is, in fact, an unexpected result in that three separate engineers at the Instituto Mexicano Del Petrolío, each certainly having at least ordinary skill in the art, stated that it was impossible to develop such a formulation.

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17. That I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date:

3/23, 2006


ARTHUR COELLO